UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,482	06/23/2003	Richard E. Michaelson	0112300-01349	1385

29159 7590 04/26/2007 BELL, BOYD & LLOYD LLP P.O. Box 1135 CHICAGO, IL 60690	**EXAMINER** NGUYEN, DAT

ART UNIT	PAPER NUMBER
3714	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
 Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>28 September 2006</u>.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-52</u> is/are pending in the application.

 4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-52</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

 a)☐ All b)☐ Some * c)☐ None of:

  1.☐ Certified copies of the priority documents have been received.

  2.☐ Certified copies of the priority documents have been received in Application No. _____.

  3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

This office action is in response to the amendments filed on 09/28/2006 in which

applicant amends claims 1, 4, 8, 13, 16, 25, 27, 30, 33, 42, 45, 49 and 52 and responds

to claim rejections. Claims 1-52 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter which the applicant regards as his invention.

Claims 1-12, and 49 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject matter

which applicant regards as the invention. Applicant claims in steps (b) and (c) of claim

1 that the player selected symbol is to be associated with one of a predefined symbol

and vice versa, however steps (g) and (h) claim a determination of whether or not the

player selected symbol is associated with one of a predefined symbol and vice versa.

These steps seem to be contradictory and fail to claim the applicant's invention since

effectively the selected symbols are already associated with the predefined symbols

from step (b) and (c). The same issues are found in independent claims 4, 8, 49 and

their dependent claims are rejected on the same basis.

Claims 25-29, 4242, 43, 45-48 and 52 are rejected under 35 U.S.C. 112, second

paragraph, as being indefinite for failing to particularly point out and distinctly claim the

subject matter which applicant regards as the invention. Applicant claims in step (e) of

claim 25 that the generated set of symbols is modified by: associating each one of the

player selected symbols with a different one of said predefined symbols, associating

each of the predefined symbols with a different one of said player selected symbols,

and for each symbol in the set which is associated with another one of said symbols,

replacing said symbol in the set with its respective associated symbol. It is unclear

which symbol (the player selected symbol or the predefined symbol) is to replace the

generated set of symbols. Furthermore, applicant claims it is replaced by its respective

associated symbol, however the examiner is unable to determine in which manner or

which symbol is to be associated with the generated set of symbols since steps (i) and

(ii) of (e) only associate the player selected symbols with the predefined symbols and

there is no relation or association to the generated set of symbols. The same issues

are found in independent claims 27, 42, 45, 52 and their dependent claims are rejected

on the same basis.

Claims 1 – 24, 27-41, 44-51 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Muir (WO 98/35309) in view of Luciano, Jr (US 6,824,465).

Claims 1, 13, and 30: Muir discloses a primary wagering game operable upon a

wager (Muir page 5:30 – 33), a plurality of player selectable symbols, a plurality of

predefined game symbols, a display device the displays the player selectable keno

numbers (Muir page 25:17 – 29). The game terminals also have a CPU that is in

communication with the display (Muir page 9:3 – 5). Muir also discloses the use of

randomly generated seeds that are used in order to generate random outcomes for the

game terminals. The server generates a random number seed for each game before

the game starts. The seed is generated and is combined with a seed index, encrypted

and sent to the console where it is stored at or prior to the start of the game play. Muir also discloses that the game console unit utilizes a seed buffer that is able to store a plurality of seeds, thus is able to store at least one seed set (Muir 17:29 – 18:11). These generated seeds are then used to generate game outcomes, wherein the outcome may be generated by a smartcard or a server (Muir 32:1 – 4). Muir also discloses the process in which the server generates multiple seeds that are used in determining multiple game outcomes (Muir 33:3 – 34:26). Muir also anticipates the bi-directional mapping of player-selected symbols with the predefined symbols. This is shown in the comparison and scoring of the keno game that determines if a player selected the correct numbers according to the game outcome (Muir 25:17 – 29). Muir discloses that the keno symbols are selectable by a player and the player selectable symbols are then compared to the game selected outcome symbols. Further more regarding the association of the at least one of the player selected symbols with one of the plurality of predefined symbols, the examiner interprets this feature as an inherent feature in all keno games wherein players are able to select from a plurality of predefined game symbols. The player selected symbols would inherently be required to associate with the plurality of predefined symbols (the entire matrix of symbols) and vice versa. Regarding the steps of determining the association of the predefined symbols with the player selected symbols, the previous step of associating the symbols with one another would make the determination step moot in that they are already deemed to be associated with one another. It would be obvious to one of ordinary skill to provide a keno game that displays to the user the symbols after being selected as modified,

changed or marked in such a manner that the player is aware of the symbols previously selected, thus preventing the player from inadvertently selecting duplicate symbols, as well as to present to the player the game selected symbols in a modified or contrasting manner so the player can thus determine the randomly generated keno symbols. However, Muir does not specifically disclose the details of the graphical presentation of a keno game and the player selectable keno symbols. Luciano, Jr (hereafter Luciano) discloses an interactive keno system that allows the player to select the keno symbols that they want to wager on. When selected, the keno symbols or numbers are modified with a "check mark" overlaid on top of the symbol (Luciano 9:22 – 26). Luciano also discloses that the game selected symbols are also modified. The game symbols are modified by a means of shading markings (Luciano 9:55 – 60). These modified or marked symbols as well as keno symbols that are unmodified in any way are presented to the player (Luciano FIGS 3 – 5).

It would be obvious to one of ordinary skill in the art to modify Muir in view of Luciano to provide a keno game that changes or marks the player selected keno symbols and the game selected keno symbols. This would allow the player to realize what symbols they selected and to see if the game selected symbols match theirs or not.

Claims 2, 14 and 31: Muir discloses the process in which the server generates multiple seeds that are transmitted to the game console which are used in determining the game outcomes (Muir 33:3 – 34:26).

Claims 3, 15, 32 and 44: Muir discloses that the player selectable symbols are numbers in a keno game (Muir 25:17 – 29).

Claims 4, 8, 16, 20, 27, 33, 37, 45, and 49 – 51: The discussion of Muir in view of Luciano is incorporated herein. Muir discloses game outcome seeds that represent different game outcomes (Muir page 3:23 – 32). Muir states "a set of random numbers sufficient to generate one or more entire game outcomes, or a random number see from which outcome information relating to a sequence of future games to be played on the console is generated by operation of a pseudo-random number algorithm." (Muir page 3:23 – 29). Thus Muir discloses a seed set. Muir also discloses that the server is capable of preventing select seeds from being use in a game by detecting the seed index number of the seed (Muir page 34:3 – 10). This prevents cheating where a random seed is reused.

Claims 5, 9, 17, 21, 28, 34, 39 and 46: Muir discloses that the seeds belonging to a seed set are "random number seeds sent from a server" (Muir page 34:3 – 5). Since the plurality of seeds are random, one of ordinary skill in the art would assume that a seed set may contain a plurality of each game outcome seed. Because the seeds are randomly generated, duplicate seed can be produced, thus leading to a plurality of each game outcome seed.

Claims 6, 10, 18, 22, 29, 35, 39 and 47: Muir states "a set of random numbers sufficient to generate one or more entire game outcomes, or a random number see from which outcome information relating to a sequence of future games to be played on the console is generated by operation of a pseudo-random number algorithm." (Muir page

3:23 – 29). Thus Muir discloses at least one seed set. Muir further discloses a plurality

of seeds that are sent to the console and a smartcard. These grouping of seeds at any

given time represent a seed set. Muir discloses that the seeds may have a limiting

lifecycle. For example, the seeds might expire after 1 hour or so. This prevents

cheating and other malicious attacks on the system. After the seeds timeout, the server

will update the console or smart card's seed set, thus providing a second and different

seed set than the first set that expired (Muir page 33:12 – 34:2).

Claims 7, 12, 19, 24, 36, 40 and 48: Muir discloses that the "said symbols are

numbers in a keno game" (Muir Page 25:17 – 29). Bb

Claims 11, 23 and 41: Muir discloses that the a central controller such as a

server is able to select or transmit a plurality of game outcome seeds selected from a

set to a plurality of game terminals or consoles (Muir FIGS 1 – 10, page 33:3 – 34:2).

Response to Arguments

Applicant's arguments filed 09/28/20006 have been fully considered but they are

not persuasive.

Applicant alleges the combination of Muir in view of Luciano Jr. (Luciano) is

improper because Luciano is said to be teaching away from Muir in that it enables

players to stop the keno game prior to each game selected symbol being picked. The

examiner respectfully disagrees. The rejection has not relied on such teachings of

Luciano for the combination, but rather the teachings of symbol marking and indication

to the player.

Applicant argues that claim 1 and similar claims are patentably different from the

prior art in that their modification is not the modification made in the manner disclosed

by the prior art. The examiner agrees, however modification as broadly interpreted

does read on the teachings of the prior art. Furthermore, the argument is drawn

towards removed subject mater and is not pertinent to the instant set of claims.

Applicant alleges that the newly amended subject mater of association of the

player selected symbols with predefined symbols and vice versa is not disclosed by the

prior art. The examiner respectfully disagrees and argues that such association would

be inherent to such games as keno wherein there is a set of predefined symbols and

players select from the set and the one of player selected predefined symbols is

associated with one of the set of predefined symbols.

Applicant alleges the prior art fails to disclose bidirectional mapping. The

examiner respectfully disagrees. The examiner believes the definition as defined by

applicant is still covered by the prior art. The examiner believes that it be an inherent

feature of the game of keno to associate a player selected symbol with that of the

predefined symbol (usually 1-80, in the embodiment of Muir). The examiner interprets

the predefined symbol as any one of the 1-80 selectable symbols of Muir's Keno

embodiment. The player selected number and that on the board must be associated

with one another and the game progresses from thereon.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dat T. Nguyen whose telephone number is (571) 272-2178. The examiner can normally be reached on M-F 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571)272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Dat Nguyen

Robert E Pezzuto
Supervisory Patent Examiner
Art Unit 3714